UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

√-0 TS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/551,399	04/17/00	CHASE C	03493.86913

EXAMINER	
HOM,S	
ART UNIT	**PAPER NUMBER**
2732	4

LM02/0912

SAMUEL H DWORETSKY ESQ
AT&T CORP
P O BOX 4110
MIDDLETOWN NJ 07749

DATE MAILED: 09/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

RA

Office Action Summary

Application No.	Applicant(s)
09/551,399	Chase et al.
Examiner: S. Hom	Group Art Unit: 2732

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 4.17.00 .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-51 is/are pending in the application.

Of the above claim(s) 11-20 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10 & 21-51 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

2. Claims 3, 10, 25, 27, 34-35, 41-45, and 51 are objected to because of the following informalities: In claim 3 line 1 delete "the internet" and insert ---the Internet---. In claim 10 line 1 delete "an internet protocol packet--- and insert ---an Internet Protocol IP packet---. In claims 25, 34-35, 41-42, 45 lines 1-2 and claims 43-44 line 3 delete "internet protocol data" and insert ---Internet Protocol IP data---. In claim 27 lines 3 and 5 delete "internet protocol address" and insert ---Internet Protocol IP address---. In claim 51 line 5 delete "internet protocol information" and insert ---Internet Protocol IP information---.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21 line 2 which recite "the fast packets" lacks clear antecedent basis because no fast packets have been previously recited in the claims and therefore the limitation is not clearly understood.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 10, and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,081,524. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claim 1 merely broaden the scope of the U.S. Patent No. 6,081,524 claim 1 by eliminating the step of generating the packet address field in response to the internet protocol IP packet data in the user data and the step of routing the IP packet through the network via the packet address field. However, the limitation that the user data includes the IP packet is now recited in claim 10. Likewise, the application's claim 22 merely broaden the scope of U.S. Patent No. 6,081,524 claim 1 by eliminating the step of switching the frame relay data packets. It has been held that the omission of a element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-10 and 21-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schibler et al. in view of Focsaneanu et al.

Schibler et al. disclose nearly all the subject matter now claimed. Note col. 3 line 63 to col. 4 line 19 which recite the method of routing having routes calculated in advance for all possible categories of hypothetical route requests whereby tables of precalculated routes are maintained wherein changes occurring in switch and network topology require only changes to the created tables and col. 4 lines 20-43 which recite the route processor accepting route request cells from various line cards within the broadband switching module, extracting service and addressing information therefrom, building and receiving route response cells, performing table lookup function through the routing tables and in response to route request received from a line card, extracts the service type, and determining whether the destination address is a single or group address clearly anticipate the method having the step of utilizing separate routing tables within an ATM switch for each service categories as in claims 24, 39-40, 46, 49, the step of routing packets responsive to the service categories as in claim 23, and means for associating a data link connection identifier according to the service category as in claim 49. Further, col. 1 lines 8-11 which recite the method and apparatus for generating route information for asynchronous transfer mode cell processing clearly anticipate the asynchronous transfer mode switch as in

claims 24, 37, 46, 50, 51, and the ATM network as in claim 22. Col. 5 lines 36-53 which recite the administration module generating and sending information using a list of switch address prefixes and corresponding switch identifications for each known switch and a list of subscriber addresses with the preferred carrier information clearly anticipate the routing tables based on customer as in claims 26 and 47 and based on data link connection identifiers as in claim 48. Col. 7 lines 22-37 which recite the step of marking the information packet whereby the first cell is marked as a beginning of message cell which contains a message identification to distinguish cells belonging to the same packet, a source address, and a destination address clearly reads on the translation circuitry for translating packets into asynchronous transfer mode cells whereby an address is assigned based on information in a user data field of the packets as in claims 31-32, 38, 43-44, the packets and cells of claim 21, and translation circuitry being responsive to the service categories as in claim 33.

Schibler et al. did not recite the use of frame relay data packets as in claims 1, 22, 31, 32, 38, 43, 44, 49-51, routing over the Internet as in claims 3, 25, 34-35, 41-45, 51, the virtual private network as in claim 5, the multicast data as in claim 7, voice and video data as in claims 8-9, the layer 3 and

layer 4 IP address as in claims 27, 36, and the step of determining routing errors as in claim 45.

Focsaneanu et al. teach that it is known to use network interfaces including X.25 packet networks, frame relay, SMDS, ATM, TCP/IP as set forth at col. 10 line 57 to col. 11 line 2 in the field of digital and multiplex communications for the purpose of providing access to telecommunications networks in multi-service environment which clearly anticipate the use of the frame relay data packets as in claims 1, 22, 31, 32, 38, 43, 44, and 49-51. Col. 2 lines 37-61 which recite the use of multimedia broadband switched networks for carrying different types of traffic, i.e. voice, data, and video information including the use of broadcasting and multicasting through the circuit switched network and accessing the Internet via the PSTN and whereby the network service providers provide access to various other private networks, academic networks etc., which contain vast numbers of databases for value added services clearly anticipate routing over the Internet as in claims 3, 25, 34-35, 41-45, 51, the virtual private network as in claim 5, the multicast data as in claim 7, and voice and video data as in claims 8-9. Col. 8 lines 41-54 which recite the layer 1 and layer 2 functionalities supported by today's modem standards whereby Layer 2 implementation include data link connection, error notification,

flow control and data unit transfer clearly anticipate the layer 3 and layer 4 IP address as in claims 27, 36, and the step of determining routing errors as in claim 45.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use frame relay data packets, routing over the Internet, virtual private network, the multicast data, voice and video data, layer 3 and layer 4 IP address, and the step of determining routing errors as taught in Focsaneanu et al. to the system of Schibler et al. because Focsaneanu et al. teach the desirable advantage of providing a more flexible and adaptable access to telecommunications network in a multi-service environment and said more flexible and adaptable access being desirable to achieve less wasteful of resources and more efficient system operation in Schibler et al.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
Price et al. disclose a method and apparatus for call routing in switched digital networks using call control tables.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5403, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist (703) 305-4700).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick Hom whose telephone number is (703) 305-4742.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4750.

DANG TON
PRIMARY EXAMINER

SH

September 8, 2000